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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,645	01/28/2002	Anthony Walter Anson	105005-0055C1	5057

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EXAMINER
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THALER, MICHAEL H

ART UNIT	PAPER NUMBER
3731	3

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	<i>M</i>
	10/058,645	Anson et al.	
	Examiner	Art Unit	
	Michael Thaler	3731	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on \_\_\_\_\_.
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 24-42 is/are pending in the application.
- 4a) Of the above, claim(s) 39 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 24-37 and 40-42 is/are rejected.
- 7)  Claim(s) 38 is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. 09/214,683.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

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This application contains claims directed to the following patentably distinct species of the claimed invention:

- a. the species of figures 8 and <sup>9</sup> 8 and
- b. the species of figures 10 and 11.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with John McKenna on March 28, 2003 a provisional election was made without traverse to prosecute the invention of figures 8-9, claims 24-38 and 40-42. Affirmation of this election must be made by applicant in replying to this Office action. Claim 39 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

The disclosure is objected to because of the following informalities: In claim 35, line 4, ". To" should be "to". Appropriate correction is required.

Claim 38 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to

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other claims in the alternative only. See MPEP § 608.01(n).

Accordingly, the claim has not been further treated on the merits.

Claims 24-34 and 40-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 24, lines 6-7 are confusing since displacing turns of a helix laterally will not make them coplanar. This may be corrected by inserting "and" after "directions" in line 7. Claims 31 and 40 have similar problems. In claim 31, lines 2-3 are confusing and are simply not understood. For example, it is unclear if alternative shapes are intended to be claimed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 and 27-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Purdy (5,527,338). Purdy shows a wire which is expandable to an occluding anchor part (e.g. 12 or 22) having turns of cycloidal form which are substantially coplanar. Alternatively, the turns are obviously substantially coplanar since any deviation from a plane is small as compared to the overall shape of the device. As to claim 27, Purdy shows another part 14 which is inherently capable of acting as an anchor part. Purdy also shows linking part (e.g. 16). As to claim 32 note col. 7, lines 23-31 of Purdy.

Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Purdy (5,527,338) in view of Mazzocchi et al. (2002/0138095). Purdy fails to show the material being a shape memory effect material. However, Mazzocchi et al. teaches that an expandable occlusion device should be made of shape memory effect material in order to insure that it expands properly (paragraphs 39-41, particularly the last sentence in paragraph 41). Using this material for the Purdy expandable occlusion device so that it too has this advantage would have been obvious.

Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Purdy (5,527,338). As to claim 33, Purdy fails to disclose the specific coating of a protein. However, it is well

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known in this art that proteins are used as pharmacological agents. Using a protein as pharmacological agent of Purdy would have been obvious for this reason. As to claim 34, Purdy fails to disclose a roughened surface on the wire. However, it is well known in this art that implanted articles in the body may have roughened surfaces in order to better retain pharmacological agents on them. Using a roughened surface on the wire of Purdy would have been obvious for this reason. As to claim 35, Purdy shows catheter 2 and placement member (the guide wire described in col. 6, line 43). Purdy, in this embodiment, fails to disclose releasable connection means. However, Purdy, in the embodiment of figure 9, teaches that a releasable connection means should be formed between the guide wire (the claimed placement member) and the occlusion device (col. 8, lines 42-51) apparently in order to insure that they do not become prematurely inadvertently separated. Including this feature in the figures 1-2 embodiment or the figure 3 embodiment of Purdy so that it too has this advantage would have been obvious.

Claims 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Kamiya et al. (5,192,301). Kamiya et al., in figure 29, show a releasable connector (the right portion of plug 21'' including the thin neck at the end of the lead line for reference numeral 21'') for releasably interconnecting first part 23 to second part (the bulbous portion of plug 21'' left of the thin neck) comprising first connector region (the flange portion which

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is wrapped around ball shaped member 28) which has a shape memory effect (col. 8, lines 52-55) and second connector region (the thin neck). As to claim 37, Webster's II New Riverside Dictionary defines "bush" as "To furnish or line with a bushing." and defines "bushing" as "A fixed or removable lining used to constrain, guide or reduce friction." The Kamiya et al. flange portion which is wrapped around ball shaped member 28 is used to constrain and thus meets this broad definition to the same extent that member 30 of the application meets it.

Claims 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Purdy (5,527,338) in view of Kamiya et al. (5,192,301). Purdy fails to disclose the connector (col. 8, lines 42-51) formed of temperature triggered shape memory material. However, Kamiya et al. teaches that a connector between the push rod and an implantable occlusion device should be formed of this material so that it can be easily disconnected when it reaches a certain temperature (col. 8, lines 45-55). So forming the Purdy connector so that it too has this advantage would have been obvious. As to claims 41 and 42, constructing the bush as claimed would have been obvious since such arrangements are old and well known in this art.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht  
March 28, 2003



MICHAEL THALER  
PRIMARY EXAMINER  
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